

III. REMARKS

1. Claims 1-20 are not unpatentable over Ohtani in view of Lee under 35 U.S.C. §103(a).

Claim 1 of Applicant's invention recites a "back cover for closing said internal compartment and covering the unit when said unit is installed into said internal compartment." This is neither disclosed nor suggested by Ohtani in view of Lee.

Ohtani relates to a movable holder in a battery mounting portion of an apparatus. The holder can reverse its direction depending on whether rechargeable or dry cell batteries are being used. A cover 24 of the battery mounting portion engages with the housing 21 to prevent the battery pack from dropping. (Col. 5, lines 40-43). As noted by the Examiner, Ohtani does not disclose or suggest the remaining features of Applicant's invention.

Lee does not overcome the deficiencies of Ohtani and the combination cannot disclose or suggest Applicant's invention. Lee merely relates to a battery for a cellular phone that has an MP3 player attached to it. The MP3 player can operate either separately from the cellular phone or together with the cellular phone. Nothing in Lee discloses or suggests "electrical contacts, on a side of said internal compartment" or that the "back cover comprises a guiding means for pushing said unit against said electronic contacts while closing said back cover." Lee is absolutely silent as to these claimed features of Applicant's invention. Thus, the combination of Ohtani and Lee does not disclose or suggest these features and claims 1, 8 and 11 cannot be considered obvious over the combination. Claims 2-7, 9, 10 and 12-20 should be allowable at least in view of their respective dependencies.

2. It is respectfully submitted that Ohtani in view of Lee does not establish a *prima facie* case of obviousness because there is simply no motivation to combine Ohtani with Lee to achieve Applicant's invention.

In order to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings. There must also be a reasonable expectation of success, and the reference(s), when combined, must teach or suggest all of the claim limitations. (See M.P.E.P. §2142). As noted above, Ohtani in view of Lee does not disclose or suggest each feature of Applicants' invention as claimed. Thus, for at least that reason a *prima facie* case of obviousness cannot be established.

Furthermore, Applicants also submit that there is no suggestion or motivation to modify the references as proposed by the Examiner to achieve Applicant's invention. The Examiner's proposition that Applicants' invention would be obvious as recited in the claims is not supported by the factual contents of Ohtani and Lee. Ohtani is directed to a movable holder in an apparatus that will adjust to accommodate a dry cell battery or a rechargeable batter. (Abstract). Lee on the other hand relates to a battery that has an MP3 player attached to it and can work while attached or unattended to a cell phone. There is absolutely no disclosure or teaching in either of the references that might lead one to combine the two references to achieve an electronic device comprising an internal compartment for retaining a detachable electronic unit, a back cover for closing the internal compartment and covering the unit when the unit is

installed into the internal compartment, and electronic contacts, on a side of the internal compartment, for establishing an electrical connection with the unit when the unit is placed into the compartment, and that the back cover comprises a guiding means for pushing the unit against the electronic contacts while closing the back cover.

A *prima facie* case of obviousness requires that the references themselves and/or the knowledge generally available to one of skill in the art provide the requisite motivation or suggestion to modify the reference as proposed for purposes of 35 U.S.C. §103(a). When "the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference". In re Rijckaert, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). Nothing in either Ohtani or Lee even remotely suggests a back cover for closing the internal compartment and covering the unit when the unit is installed into the internal compartment, electrical contacts on a side of the internal compartment or that the back cover comprises guiding means as claimed by Applicant. The Examiner is requested to provide an indication as to where any such teaching, suggestion or motivation appears in the references. Absent such a teaching, it is submitted that a *prima facie* case of obviousness over Ohtani and Lee under 35 U.S.C. §103(a) is not established.

3. The Applicants also respectfully note that Ohtani and Lee have been combined improperly. References may be combined under 35 U.S.C. §103(a) only if the references are analogous art. In this case Ohtani and Lee are not analogous art. A reference is analogous art if:

- 1) The reference is in the same field of endeavor as the applicant's, or
- 2) The reference is reasonably pertinent to the particular problem with which the applicant was concerned.

Neither Ohtani nor Lee are in the same field as the Applicants' invention. Ohtani is directed to a movable holder in a battery mounting portion of an apparatus. The holder can essentially adjust for various battery sizes, such as rechargeable or dry cell batteries. (Abstract). Applicant's invention is directed to securing an electronic unit into an operating position and enabling easy insertion and detachment of the unit. (page 1, lines 1-5). Claim 1 recites the specific features. Thus, these are not the same fields of endeavor. Similarly, Lee is not reasonably pertinent to the particular problem with which the Applicants were concerned. Lee puts an MP3 on a battery pack. The battery pack with the MP3 player can be used to power a cellular phone, or the MP3 player and battery pack can be used independently of the cellular phone. Nothing in Lee is even remotely related to securing an electronic unit into an operating position and enabling easy insertion and detachment of the unit. (page 1, lines 1-5). For these same reasons, the references are not even related to each other. Thus, Ohtani and Lee do not address the problems addressed by Applicants' invention, are not in the same field of endeavor as the Applicants' endeavor and are not reasonably pertinent to the particular problem with which the Applicants were concerned. Thus, Ohtani and Lee are not analogous art. Therefore, Ohtani may not properly be combined with Lee.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,



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29 June 2004

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